



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNIU79.013AUS	6418

20995 7590 12/07/2010
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
----------	--------------

1788

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
efiling@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No. 10/618,957	Applicant(s) YAMAMOTO ET AL.	
	Examiner VICTOR S. CHANG	Art Unit 1788	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-13, 15-17, 19, 20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12, 15, 19, 20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Applicants' arguments and amendments filed 11/24/2010 have been entered. Claims 10-13, 15, 19, 20 and 23 have been amended. Claims 8, 14, 21 and 22 have been cancelled. Claims 10-12, 15, 19, 20 and 23 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendment, the grounds of rejection have been updated. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 103

4. Claims 10-12, 15, 19, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi (US 6582789) in view of JP 1-174538 (Derwent Abstract).

Sumi's invention relates to a protective film for liquid crystal display. See Abstract. The film is treated by an antistatic agent on the surface of the surface protective film opposite to the surface in which the adhesive layer is formed. See Abstract. Useful films include biaxially oriented polyethylene terephthalate (PET) film. See col. 3, ll. 6 and 18. The thickness of the adhesive layer is preferably 3 to 50 micrometers. See col. 5, ll. 60. Examples of adhesives include acrylic adhesive having 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1. See col. 15, ll. 60-63.

Art Unit: 1788

For claims 10-12, 15, 19, 20 and 23, Sumi lacks a teaching of an antistatic layer comprising a blend of a polymer having pyrrolidinium rings and polyvinyl alcohol. However, JP ‘538 relates to a transparent stretched polyester film having an antistatic coating comprising polyvinyl alcohol and a polymer having pyrrolidinium rings. It would have been an obvious modification to one of ordinary skill in the art to modify the antistatic layer of Sumi with the transparent antistatic coating of JP ‘538, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Regarding the functional limitation “being configured to maintain transparency even after one-hour heat treatment at 150°C”, absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above.

5. Claims 10-12, 15, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 (machine translation) in view of JP 1-174538 (Derwent Abstract).

JP ‘116 relates to a transparent surface-protective film for various displays. See [0002]. The film comprises a highly transparent polyethylene terephthalate (PET) film, which is preferably biaxially oriented. An antistatic layer is provided on one side of the PET film, and an adhesive layer is provided on the opposite side. See [abstract]. The thickness of the adhesive layer is 3-100 micrometers. See [0040]. Useful adhesives include acrylic pressure sensitive adhesive. See [0035].

Art Unit: 1788

For claims 10-12, 15, 20 and 23, JP '116 lacks a teaching to form the antistatic layer of polymers having pyrrolidinium rings as multiple repeating units in main chains. However, JP '538 relates to a transparent stretched polyester film having an antistatic coating comprising polyvinyl alcohol and a polymer having pyrrolidinium rings. It would have been an obvious modification to one of ordinary skill in the art to modify the antistatic layer of JP '116 with the transparent antistatic coating of JP '538, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the use limitations in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Regarding the functional limitation "being configured to maintain transparency even after one-hour heat treatment at 150°C", absent any evidence to the contrary, it is deemed to be inherent to the same structure and composition of the film as the claimed invention, which is rendered obvious by the collective teachings of prior art as set forth above.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-256116 (machine translation) in view of JP 1-174538 (Derwent Abstract) and Sumi (US 6582789).

The teachings of prior art are again relied upon as set forth above.

For claim 19, the prior art is silent about the amount of co-monomer in the acrylic adhesive. However, Sumi's invention relates to a protective film, and exemplifies a useful acrylic adhesive comprising 2-ethylhexyl acrylate as a main monomer, vinyl acetate as a comonomer and hydroxyethyl methacrylate as a functional group-containing monomer in a ratio of 7:2:1. See col. 15, ll. 60-63. It would have been an obvious to one of ordinary skill in the art

Art Unit: 1788

to select a known acrylic adhesive composition of Sumi to make the protective film of JP '116, because the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

Response to Arguments

7. In view of the updated grounds of rejections, applicants' arguments at Remarks page 4-5 are moot.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1788

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1788